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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of application Serial Nos.:

85/499,349 for the mark **CHLORADERM**
85/499,345 for the mark **CHLORABSORB**
85/499,337 for the mark **CHLORABOND**
85/499,332 for the mark **CHLORADRAPE**

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CAREFUSION 2200, INC.,

Opposer,

v.

ENTROTECH LIFE SCIENCES, INC.,

Applicant.

Combined Opposition Proceeding No.: 91-206,212

ORAL ARGUMENT REQUESTED

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

TRIAL BRIEF OF APPLICANT ENTROTECH LIFE SCIENCES, INC.

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I. PRELIMINARY STATEMENT

Opposer Carefusion 2200, Inc. (“Opposer”) opposes Applicant Entrotech Life Sciences, Inc.’s (“Applicant”) applications for registration of the marks CHLORADRAPE (Ser. No. 85/499,332), CHLORABOND (Ser. No. 85/499,337), CHLORABSORB (Ser. No. 85/499,345) and CHLORADERM (Ser. No. 85/499,349) (collectively, the “Applications”). Opposer’s opposition is without merit because Applicant’s marks are not likely to result in confusion with Opposer, its CHLORAPREP or CHLORASHIELD marks, or any goods offered thereunder. Additionally, Opposer has waived its claim of lack of bona fide intent to use by failing to raise any argument or cite any evidence in support of its claim in its trial brief. *See* TBMP 801.01 (“If a party fails to reference a pleaded claim or affirmative defense in its brief, the Board will deem the claim or affirmative defense to have been waived.”)

Applicant submits this trial brief in support of its position.

II. DESCRIPTION OF THE RECORD

The record in this matter consists of the following materials:

1. The trial testimony of Opposer’s witness Jennifer Raeder-Devens and accompanying exhibits, taken by Opposer on March 13, 2015 and filed by Opposer on September 4, 2015 [Dkt. 79].
2. The trial testimony of Applicant’s witness Dr. George J. Holinga and accompanying exhibits, taken by Applicant on May 14, 2015.
3. The trial testimony of Applicant’s witness James E. McGuire and accompanying exhibits, taken by Applicant on May 12, 2015.
4. The trial testimony of Opposer’s witness Jan Creidenberg and accompanying exhibits, taken by Opposer on March 12, 2015 and filed by Opposer on August 20, 2015 [Dkt. 77].
5. The trial testimony of Opposer’s rebuttal witness Jennifer Raeder-Devens and accompanying exhibits, taken by Opposer on June 23, 2015 and filed by Opposer on August 20, 2015 [Dkt. 76].

6. The trial testimony of Opposer's rebuttal witness Carol Schultz and accompanying exhibits, taken by Opposer on June 23, 2015 and filed by Opposer on August 19, 2015 [Dkt. 75].
7. Subject to Applicant's objection, Opposer's Notice of Reliance pursuant to 37 C.F.R. § 2.122(e) dated March 5, 2015 offering articles regarding the recognition of CHLORAPREP.
8. Opposer's Notice of Reliance pursuant to 37 C.F.R. § 2.122(e) dated March 5, 2015 offering printouts from the United States Patent and Trademark Office's TESS and ASSIGN databases for Registration Nos. 1,930,248, 4,052,849, and 4,488,745.
9. The discovery deposition of James E. McGuire and accompanying exhibits, taken by Opposer on December 10, 2014 and filed by Opposer under a Notice of Reliance on March 5, 2015 [Dkt. 44,45, 46].
10. Subject to Applicant's objection and its pending Motion to Strike, the discovery deposition of John Halsey and accompanying exhibits, taken by Opposer on December 12, 2014 and offered into evidence by Opposer under a Notice of Reliance [Dkt. 59].
11. Subject to Applicant's objection and its pending Motion to Strike, the discovery deposition of John Foor, M.D. and accompanying exhibits, taken by Opposer on June 17, 2014 and offered into evidence by Opposer under a Notice of Reliance [Dkt. 58].
12. Opposer's Notice of Reliance pursuant to 37 C.F.R. § 2.122(e) dated March 19, 2015 offering a printout from the United States Patent and Trademark Office's TESS and ASSIGN databases for Application Serial No. 86/473,970 [Dkt. 48].
13. Opposer's Notice of Reliance pursuant to 37 C.F.R. § 2.122(e) dated March 19, 2015 offering ten (10) printouts from the United States Patent and Trademark Office's TESS and ASSIGN databases of third-party registrations for marks with the CHLORA prefix [Dkt. 49].
14. Opposer's Notice of Reliance pursuant to 37 C.F.R. § 2.122(e) dated March 19, 2015 offering twenty-two (22) printouts from the United States Patent and Trademark Office's TESS and ASSIGN databases of third-party registrations for goods competitive with Opposer's CHLORAPREP and CHLORASHIELD goods [Dkt. 50].
15. Opposer's Notice of Reliance pursuant to 37 C.F.R. § 2.120(j) dated March 19, 2015 including two (2) interrogatories and responses [Dkt. 51].
16. Opposer's Amended Notice of Reliance pursuant to 37 C.F.R. § 2.120(j) dated March 23, 2015 including two (2) interrogatories and responses [Dkt. 52].
17. Subject to Applicant's objection, Opposer's Notice of Reliance pursuant to 37 C.F.R. § 2.122(e) dated July 1, 2015 offering a blog entry from Allnurses.com.

18. Applicant's Notice of Reliance pursuant to 37 C.F.R. § 2.120(j) making of record responses from Opposer to Applicant's interrogatories and Applicant's request for admission (Exhibits D1 and D2) [Dkt. 61].
19. Applicant's Notice of Reliance pursuant to 37 C.F.R. § 2.120(e) making of record third-party United States trademark applications for marks containing the letters "C-H-L-O-R" or "C-H-L-O-R-A" for goods relevant to this Opposition (Exhibits B1 – B6) [Dkt. 62].
20. Filed Under Seal Pursuant to Stipulated Protective Order, Applicant's Notice of Reliance pursuant to 37 C.F.R. § 2.120(j) making of record the redacted version of the discovery deposition of Opposer taken under Rule 30(b)(6) of the Federal Rules of Civil Procedure of Mr. Jan Creidenberg (Exhibit C1) [Dkt. 63].
21. Applicant's Notice of Reliance pursuant to 37 C.F.R. § 2.120(e) making of record third-party United States trademark registrations for marks containing the letters "C-H-L-O-R" or "C-H-L-O-R-A" for goods relevant to this Opposition (Exhibits A1 – A24) [Dkt. 64].
22. Applicant's Notice of Reliance pursuant to 37 C.F.R. § 2.120(e) making of record publicly available Internet materials to establish the weakness of the CHLORAPREP mark and product and any goodwill Opposer alleges either may have (Exhibits J1 – J4) [Dkt. 65].
23. Applicant's Notice of Reliance pursuant to 37 C.F.R. § 2.120(e) making of record publicly available Internet materials to establish the co-existence in the marketplace of Opposer's CHLORAPREP and CHLORASHIELD marks with other marks containing the letters "C-H-L-O-R" or "C-H-L-O-R-A" for goods relevant to this Opposition (Exhibits F1 – F34) [Dkt. 66].
24. Applicant's Notice of Reliance pursuant to 37 C.F.R. § 2.120(e) making of record publicly available Internet materials to establish the purchasing conditions and the sophistication of the purchasers of the goods at issue in this Opposition (Exhibits G1 – G7) [Dkt. 67].
25. Applicant's Notice of Reliance pursuant to 37 C.F.R. § 2.120(e) making of record publicly available Internet materials to establish the scope of Opposer's use of its CHLORAPREP and CHLORASHIELD marks and the co-existence in the marketplace of Opposer's CHLORAPREP and CHLORASHIELD marks with other marks containing the letters "C-H-L-O-R" for goods relevant to this Opposition (Exhibits I1 – I14) [Dkt. 68].
26. Applicant's Notice of Reliance pursuant to 37 C.F.R. § 2.120(e) making of record official records relating to the marks at issue in this Opposition (Exhibits E1 – E20) [Dkt. 69].

27. Filed Under Seal Pursuant to Stipulated Protective Order, Applicant's Notice of Reliance pursuant to 37 C.F.R. § 2.120(j) making of record Opposer's discovery response and documents produced to Applicant in this Opposition (Exhibits H1 – H5) [Dkt. 70].

III. STATEMENT OF THE ISSUE

The sole issue in this consolidated Opposition proceeding is whether Applicant is entitled to registration of the marks CHLORADERM, CHLORABSORB, CHLORABOND, and CHLORADRAPE as they appear in the subject applications for the goods identified in Application Serial Nos. 85/499,349, 85/499,345, 85/499,337, and 85/499,332, respectively.

IV. RECITATION OF THE FACTS

A. Applicant and the Entrotech Group of Companies

Applicant is one of several companies affiliated with entrotech, inc. ("Entrotech"). Jim McGuire began Entrotech in 1999 after years of working as a chemist and scientist for large industrial companies. (Trial Testimony of James McGuire ("McGuire Tr."), 32:17-18). A specialist in adhesive technology (Discovery Testimony of James McGuire ("McGuire Disc"), 9:19-21, 10:16-18) and problem-solver by nature (McGuire Tr., 24:16-18), McGuire began Entrotech with the intention of creating an alternative to the overly-corporatized old guard of companies – such as Opposer – operating in the advanced materials space. Entrotech's home is the lab, not the conference room; it is a meritocracy rewarding innovation, not contributions to a healthy EBITDA; it invests in innovation, not refining what is already established and proven; and it prizes efficiency and collaboration over blind adherence to antiquated business methods. (McGuire Tr., 42:11-17, 46:1-11, 78:23-79:9, 105:21-106:15, 122:13-123:7; Trial Testimony of George Holinga ("Holinga Tr."), 41:3-44:2, 74:11-25.) Accordingly, Entrotech's name is derived from the word "entropy," an acknowledgement that it embraces disorder and

counterintuitive solutions, as opposed to simply embracing corporate norms. (McGuire Tr., 41:17-42:17.)

[REDACTED]

(McGuire Tr., 10:12-20; AX 1.) Along with Applicant, which is in the life sciences industry, Entrotech's affiliates include: Entrochem, which is in the acrylate and urethane chemistries industry; Entrotech Electronic Materials, which works on adhesives in the electronics industry; Entrotech Composites, which is in the carbon fiber industry; and Entrochem Manufacturing and Fulfillment, which manufactures certain of Entrotech's products, including the products offered under the CHLORADRAPE and CHLORADERM marks. (McGuire Tr., 43:19-45:13.) [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] (McGuire 10:12-20, 38:6-41:13; AX 1.)

In addition to the products at issue in this proceeding (which are addressed below), Entrotech has significant experience developing medical devices and other products in the medical field. [REDACTED]

[REDACTED] (McGuire Tr., 63:13-64:9; McGuire Disc., 37:22-39:19.) Similarly, Entrotech has developed trauma care devices [REDACTED], including: BATTLEVIEW, which allows its users to locate veins for intravenous administration of fluids; BATTLEWRAP, BATTLE BANDAGE, and CROC, devices to control hemorrhages [REDACTED]; and SENTINEL, a seal [REDACTED]. (McGuire Tr., 165:24-168:21.) Applicant's research and development of medical products echoes one of Entrotech's founding principles, namely, to "save lives, whether it's on the

battlefield or in the hospital or in a clinic.” (Holinga Tr., 40:19-41:2; McGuire Disc., 156:11-18.)

B. Opposer and Its CHLORAPREP and CHLORASHIELD Marks

Opposer owns and has asserted in this proceeding the following registrations:

1. CHLORAPREP (Reg. No. 1,930,248) for “topical antimicrobial solutions”;
2. CHLORAPREP (Reg. No. 4,052,849) for “broad-spectrum antiseptic”; and
3. CHLORASHIELD (Reg. No. 4,488,745) for “antimicrobial catheter patch dressing.”

Opposer’s products offered under these marks are antiseptic products. Each of the products’ active ingredient is chlorhexidine gluconate (“CHG”), a salt form of the chlorhexidine molecule. (Trial Testimony of Jennifer Raeder-Devens (“Raeder-Devens Tr.”), 52:9-25.)

Chlorhexidine is a powerful antimicrobial. (Holinga Tr., 46:5-14.) As its name indicates, the chlorhexidine molecule (and CHG) includes two chlorine atoms which are central to the chemical structure of the molecule and its effectiveness as an antiseptic. (Holinga Tr., 143:1-8; McGuire Tr., 73:23-74:20.)

The terms CHLOR, CHLORA, and CHLORO are frequently used – often as a prefix – to indicate products that, like CHLORAPREP and CHLOROSHIELD, include, in one form or another, chlorine, many of which have disinfectant or antiseptic properties. (Holinga Tr. 143:1-

144:3, 146:5-17; McGuire Tr., 174:4-17, 175:17-21, 259:25-260:15.) The Principal Register is replete with such marks (NOR 49; NOR 64; OX 80):

| Mark | Reg. No. | Identification of Goods and Nature of Use in Commerce |
|---------------------------|-----------------|--|
| CHLORAG+ARD (Stylized) | 4,071,394 | Class 10: Antiseptic catheter surface sold as an integral component of catheters Catheter with chlorhexidine solution chemically bonded to its surface (NOR 66, Ex. F6) |
| CHLORASEB | 4,012,226 | Class 5: Antibacterial and antifungal sprays for use on pets and animals Antiseptic spray for pets and animals; 2% chlorhexidine (NOR 66, Ex. F2; OX 90) |
| CHLORAZENE | 1,530,509 | Class 5: Antiseptic powder Additive to whirlpools to cleanse open wounds, promote healing; anti-microbial formula (NOR 66, Ex. F3; OX 84.) |
| CHLORADINE | 3,608,454 | Class 5: Antimicrobial solution for teat dip; disinfectant for veterinary use 2% CHG formula for prepping animal surfaces prior to surgery (NOR 66, Ex. F4; OX 88.) |
| CHLORACEL | 0,649,510 | Class 1: Sodium aluminum chlorhydroxy lactate and other aluminum chlorhydroxy compounds Antiperspirant (OX 81) |
| CHLORO-SOL | 2,717,529 | Class 5: All-purpose disinfectant spray and towelettes premoistened with disinfectants Bleach disinfectant solution for decontamination of healthcare surfaces (NOR 66, Ex. F7) |
| CHLOROSTAT | 1,600,325 | Class 5: Antimicrobial skin cleanser Topical antimicrobial chlorhexidine solution (NOR 66, Ex. F8) |
| AGRICHLOR | 4,301,656 | Class 5: Bactericides and biocides |

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| | | Chlorine-based disinfectant solution (NOR 66, Ex. F9) |
| H-CHLOR | 4,518,543 | Class 5: Medical cleansers for skin and wounds containing sodium hypochlorite; Pharmaceutical preparations for wounds containing sodium hypochlorite Chlorine-based solution with antimicrobial effect meant to treat skin and tissue infections (NOR 66, Ex. F10) |
| TRICHLOR-O-CIDE (Stylized) | 645,578 | Class 5: Powdered bactericide for household or industrial use |
| CHLORLITE | 2,328,894 | Class 3: Concentrated laundry destainer Hypochlorite-based stain remover (NOR 66, Ex. F11) |
| CHLORCID | 2,057,459 | Class 5: Dental preparations, namely, disinfecting solutions for irrigating, debriding and disinfecting a root canal |
| CHLOROPTIC | 888,556 | Class 5: Ophthalmic preparations |
| VALCHLOR | 4,538,181 | Class 5: Pharmaceutical preparations for the treatment of lymphomas, non-Hodgkins lymphomas, cutaneous T cell lymphomas, mycosis fungoides Mechlorethamine-based gel for treatment of lymphoma (NOR 66, Ex. F12) |
| SOCHLOR | 2,674,665 | Class 5: Medicated eye products, namely, hypertonic solutions and ointments for the eyes Sodium chloride-hypertonic solution for eyes (NOR 66, Ex. F13) |
| VITAL-CHLOR | 4,388,724 | Class 5: Pharmaceutical products, namely, medicated shampoos, skin cleansers, body cleansers, hair cleansers, skin conditioners, body conditioners, and hair conditioners; pharmaceutical preparations for skin care; fungal medications |

| | | |
|-------------|-----------|---|
| | | CHG-based antibacterial shampoo for animals (NOR 66, Ex. F14) |
| ECONO-CHLOR | 4,344,115 | Class 1: Water treatment chemicals for use in swimming pools and spas |
| HYDROCHLOR | 4,290,040 | Class 5: Whirlpool and spa deodorizer Bacteria-killing additive to hydrotherapy treatments (NOR 66, Ex. F16) |
| HYPO-CHLOR | 3,226,832 | Class 5: Sterile sodium hypochlorite for use as a decontaminate and as a disinfectant in clean rooms Disinfectant for cleanrooms and controlled areas (NOR 66, Ex. F17) |
| POWER CHLOR | 3,759,034 | Class 5: Bactericides; sanitizers and algacides for use in swimming pools Bactericide for use in pool (NOR 66, Ex. F18) |
| TOP-CHLOR | 3,621,333 | Class 1: Swimming pool water treatment chemicals, namely, chlorine Chlorine tablets for use in pools (NOR 66, Ex. F19) |
| NAT-CHLOR | 1,383,844 | Class 1: Swimming pool water treatment chemicals, namely, chlorine |
| VALUE CHLOR | 2,167,634 | Class 1: Chlorine for use in swimming pools |
| CHLORALLOY | 1,012,945 | Class 19: Sheets of synthetic polymer material for construction purposes, particularly shower lines Shower pan liner waterproofing membrane; made from chlorinated polyethelone (OX 83) |
| CHLORAZONE | 2,219,205 | Class 1: Synthetic polymer in the form of solid slabs, strips and other pre-formed solid shapes, used to manufacture a wide variety of products intended to be in regular contact with water Rubber toilet flapper designed to withstand |

| | | |
|--|--|--|
| | | chemicals in water, specifically free chlorine and chloramines (OX 85) |
|--|--|--|

Likewise, there are many common law uses of CHLOR for goods that include chlorine, many of which have disinfectant or antiseptic properties:

| Mark | Nature of Use in Commerce |
|--------------|--|
| CHLOR-XTRA | Sodium hypochlorite solution; used for irrigation, debridement and cleansing of root canals during and after instrumentation (NOR 66, Ex. F20) |
| SOCHLOR | Chlorine disinfectant wipes and other products (NOR 66, Ex. F21) |
| ENOCHLOR | Calcium hypochlorite; used as bactericide in drinking water, swimming pool water, etc . . . (NOR 66, Ex. F22) |
| CHLORA CLENS | Pet wound care spray that includes chlorhexidine (NOR 66, Ex. F23) |
| CHLORA-DIP | Teet dip that includes chlorhexidine (NOR 66, Ex. F24) |
| CHLORA TABS | Chloramphenicol product (NOR 66, Ex. F25) |
| CHLORACOL | Chloramphenicol product used to treat bacterial eye infections (NOR 66, Ex. F26) |
| NAT-CHLOR | Chlorine product to stabilize chlorine levels for swimming pools (NOR 66, Ex. F27) |
| ECONOCHLOR | Antibiotic eye drop (NOR, Ex. F15) |

Additionally, there are pending allowed applications of marks that include chlorine, many of which have disinfectant or antiseptic properties (NOR 62):

| Mark | Ser. No. | Identification of Goods |
|--------------|-----------------|------------------------------------|
| CHLORIGATE | 85/770,389 | Class 5: Bactericides and biocides |
| CHLORIGATION | 85/770,419 | Class 5: Bactericides and |

| | | |
|---------------------|------------|--|
| | | biocides |
| QUADRACHLOR | 86/159,827 | Class 5: Medicated skin care preparations, namely, creams, lotions, ointments, and suspensions; Gels, creams and solutions for dermatological use; Medicated ointments for treating dermatological conditions; Medicated shampoos |
| ENOCHLOR (Stylized) | 86/472,081 | Class 5: All purpose disinfectants for inhibiting growth of bacteria; Antiparasitic preparations; Antiseptics; Chemical preparations to treat mildew; Depuratives for the body; Disinfectants for chemical toilets; Disinfectants for hygiene purposes; Germicides; Pharmaceutical preparations for use in chemotherapy; Sterilising preparations and substances |
| SMARTCHLOR | 86/288,035 | Class 1: Water purification chemicals contained in cartridges and dispensers for use in killing bacteria and algae in swimming pool, hot tub and spa; algacides and bactericides for swimming pool, hot tubs and spas |
| IV CHLOR | 86/223,486 | Class 1: Sodium hypochlorite |

Like the above marks, Opposer's CHLORAPREP and CHLORASHIELD marks follow the established convention of indicating the presence of chlorhexidine or chlorine in their respective products by using the CHLOR or CHLORA prefix.¹

¹ Opposer's witnesses evaded testifying as to the meaning or derivation of the CHLORA component of their marks. (Discovery Testimony of Jan Creidenberg ("Creidenberg Disc.") 73:17-76:2.) Nevertheless, Opposer admits in its trial brief that it uses "the 'chlora' prefix to reference use of the chlorhexidine molecule." (Dkt. No. 82 ("Opposer's Tr. Brief."), p. 31.)

The suffixes of each mark – PREP and SHIELD, respectively – are similarly descriptive. PREP in CHLORAPREP describes preoperative skin preparation. (Creidenberg Disc., 72:25-73:5; Trial Testimony of Jan Creidenberg (“Creidenberg Tr.”), 255:10-13; NOR 68, Ex. I2.) SHIELD in CHLORASHIELD describes the product’s function of shielding or protecting the insertion site from the outside environment. (Creidenberg Tr., 255:14-20; NOR 68, Ex. I4.)

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

CHLORAPREP has peacefully coexisted in the marketplace with the above-listed marks despite their common use of the term CHLOR. Notably, in 2005, the Division of Medication Errors and Technical Support (“DMETS”) of the Center for Drug Evaluation and Research considered whether use of the brand name CHLORASCRUB for goods largely identical to those offered by Opposer under the CHLORAPREP mark could co-exist without confusion in the marketplace with CHLORAPREP. (NOR 69, Ex. E9.) DMETS ultimately determined that CHLORASCRUB and CHLORAPREP “may coexist in the marketplace” based, in part, on their “lack of convincing orthographic and phonetic similarities.” (*Id.*)²

Opposer sells its CHLORAPREP products [REDACTED]
[REDACTED]. (Creidenberg Disc. 45:13-15, 140:19-141:20; Creidenberg Tr., 269:4-16.) Although its CHLORASHIELD product is in its infancy, purchase orders for that product

² [REDACTED]

range from [REDACTED]. (Creidenberg Tr., 271:22-272:3; OX 65.) Opposer’s goal is to [REDACTED]
[REDACTED]. (Creidenberg Tr.,
269:10-270:18.)

[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]

Opposer’s marketing efforts related to the CHLORAPREP products have been subject to scrutiny. Specifically, in January 2014, Opposer agreed to pay \$40.1 million “to settle civil [False Claims Act] allegations that it paid kickbacks . . . to the physician co-chair of the Safe Practices Committee at the National Quality Forum . . . and . . . knowingly promoted the sale of Chloraprep for uses that the FDA had not approved, some of which were not medically accepted

indications, and made unsubstantiated representations about the appropriate uses of Chloraprep.” (NOR 68, Ex. I1, pp. 22-23.) Opposer’s malfeasance was the subject of a press release issued by the Department of Justice and was widely reported in the industry. (AX 14; McGuire Tr., 160:4-164:2.)

Also, Opposer’s CHLORAPREP products have been criticized by nurses and other professionals because surgical drapes do not adequately adhere to skin prepared with CHLORAPREP products. (AX 52, pp. 3-4; McGuire Tr., 247:8-249:21.) [REDACTED]

[REDACTED]

[REDACTED]

(McGuire Disc., 76:8-12; McGuire Tr., 243:21-244:8, 245:5-23.) [REDACTED]

[REDACTED]

[REDACTED]. (140:25-142:2.)

C. Entrotech’s Failed Collaboration with Opposer on a Chlorhexidine-Impregnated Surgical Incise Drape

i. The Significant Market Demand for a Chlorhexidine-Impregnated Surgical Incise Drape

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

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[REDACTED]

[REDACTED]

[REDACTED]

⁵ [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

iii. Opposer's Allegations that Entrotech Acted or Competed Unfairly Are Baseless

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

⁶ Opposer's application to register CHLORASHIELD for "surgical incise drape" matured to registration on March 11, 2014. (NOR 69, Ex. E1.) Opposer pleaded its application in its notice of opposition and, later, pleaded its registration in its first amended notice of opposition. (Dkt. Nos. 1, 23.)

[REDACTED]

⁷ [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

D. Applicant's Chlorhexidine-Based Products

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] Consistent with the naming convention described above, each of these product names combines the CHLORA prefix – to indicate that it serves an antiseptic function – with a term that describes the nature or function of the product:

1. CHLORADRAPE is Applicant's brand name for its chlorhexidine-impregnated surgical incise drape. The name's suffix – DRAPE – refers to the product type. (McGuire Tr., 189:22-190:12.) [REDACTED]

[REDACTED]

[REDACTED] (McGuire Tr., 208:7-209:25, 213:3-214:4.) As noted above, there are no chlorhexidine-impregnated surgical incise drapes on the market.

2. CHLORADERM is Applicant's brand name for its antimicrobial thin film dressing. The name's suffix – DERM – refers to skin, i.e., epidermis, connoting where the product is used and the thin skin-like composition of the product. (*Id.*, 220:1-10.) [REDACTED]
3. CHLORABSORB is Applicant's brand name for its antimicrobial thin film dressing with an absorbent pad in the center. (*Id.*, 238:4-15.) The name's suffix – ABSORB – refers to the absorbent properties of the product's pad. (*Id.*, 238:22-239:1.) [REDACTED] (*Id.*, 239:15-240:3.)
4. CHLORABOND is Applicant's brand name for its high-adhesion topical antimicrobial solution. (*Id.*, 173:15-18, 241:14-18.) The name's suffix – BOND – refers to the product's adhesive properties. (*Id.*, 242:5-18.) Applicant has filed patent applications for the product's underlying invention. (*Id.*, 243:9-20.)

Applicant filed intent-to-use trademark applications for the above brand names on December 19, 2011, and they were published for opposition on May 29, 2012.

Applicant did not select these brand names intending to associate its products with any products in the marketplace, much less Opposer's. (*Id.*, 262:14-17.) In fact, Applicant's products – particularly CHLORABOND – was developed to improve upon the CHLORAPREP product's well-established poor adhesive qualities. This is especially the case now that Opposer

and its CHLORAPREP product were the subject of a highly-publicized DOJ investigation, complaint, and settlement. (*Id.*, 164:3-25.)

V. ARGUMENT

Opposer's First Amended Notice of Opposition asserts two grounds for refusing registration to Applicant's marks: (i) a likelihood of confusion between Applicant's marks and Opposer's registrations of CHLORAPREP and CHLORASHIELD; and (ii) Applicant's lack of a bona fide intent to use its marks at the time it filed its Applications. (Dkt. No. 24.) Opposer has not presented any evidence of Applicant's lack of a bona fide intent to use its marks or any argument in support of this claim in its trial brief. Thus, the Board should deem it waived. *See* TBMP 801.01 ("If a party fails to reference a pleaded claim or affirmative defense in its brief, the Board will deem the claim or affirmative defense to have been waived.") Accordingly, the only ground for opposition before the Board is Opposer's claim under 15 U.S.C. § 1052(d).

A. Legal Standard

"In opposition proceedings, the opposer bears the burden of establishing that the applicant does not have the right to register its mark." *Hoover Co. v. Royal Appliance Mfg. Co.*, 57 U.S.P.Q.2d 1720, 1722 (Fed. Cir. 2001). Thus, the opposer who relies on 15 U.S.C. § 1052(d) must "both establish a prima facie case of likelihood of confusion and carry the ultimate burden of persuasion." *Yamaha International Corp. v. Hoshino Gakki Co.*, 6 U.S.P.Q.2d 1001, 1007 (Fed. Cir. 1988). Although, as Opposer notes, doubts as to whether confusion is likely are to be resolved against the newcomer, this presumption applies "especially where the established mark is one which is famous and applied to an inexpensive product bought by all kinds of people without much care." *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 223 U.S.P.Q. 1281, 1285 (Fed. Cir. 1984). As described below, none of these circumstances is present in this case.

In order to determine the likelihood of confusion, the Board considers the factors set forth in *In re E.I. du Pont de Nemours & Co.*, 177 U.S.P.Q. 563, 567 (CCPA 1973). The *du Pont* factors are not to be mechanically applied. See *Citigroup, Inc. v. Capital City Bank Group, Inc.*, 98 U.S.P.Q.2d 1253, 1261 (Fed. Cir. 2011) (“Citigroup’s approach of mechanically tallying the *Dupont* factors addressed is improper, as the factors have differing weights.”). Likewise, the *DuPont* factors are not listed in order of merit, and any one of them may be dispositive in a case without consideration of the remaining factors. *du Pont*, 177 U.S.P.Q. at 567; *Kellogg Co. v. Pack’Em Enterprises, Inc.*, 21 U.S.P.Q.2d 1142, 1145 (Fed. Cir. 1991) (“We know of no reason why, in a particular case, a single *du Pont* factor may not be dispositive.”). Each case must be decided on its own facts, taking into account those *du Pont* factors that are most relevant to the particular case. *du Pont*, 177 U.S.P.Q. at 567. Clearly a fact-intensive inquiry, “[l]ikelihood of confusion . . . is an ultimate conclusion which must be reached on all the circumstances of the case at bar.” *Bongrain International (American) Corporation v. Delice de France, Inc.*, 1 U.S.P.Q.2d 1775, 1779 (Fed. Cir. 1987). Accordingly, the Board has stated that “trademark law must necessarily be flexible responding to particular circumstances disclosed by particular fact circumstances.” *In re Sydel Lingerie Co., Inc.*, 197 U.S.P.Q. 629, 630 (TTAB 1977).

B. Applicant’s Marks Do Not Create a Likelihood of Confusion With Opposer’s Marks

i. Opposer’s Marks Are Weak and Entitled to, At Most, Narrow Protection

That Opposer’s CHLORAPREP registrations are incontestable does not, in and of itself, prove that its CHLORAPREP mark is strong. See *Therma-Scan, Inc. v. Thermoscan, Inc.*, 63 U.S.P.Q.2d 1659, 1663 (6th Cir. 2002) (plaintiff’s reliance on incontestable status of mark to prove strength is “misplaced”). Likewise, Applicant may attack the strength of Opposer’s marks without it constituting a collateral attack on Opposer’s registrations. *U.S. Steel Corp. v. The*

Nat'l Copper & Smelting Co., 131 U.S.P.Q. 397, 399 (TTAB 1961). Here, the weakness of Opposer's marks weighs heavily against a finding of a likelihood of confusion.

1. Opposer's Marks Are Composed of Descriptive Components

Opposer's marks are composed of descriptive components and, thus, are weak.⁸ As explained above, Opposer's marks follow the established naming convention of using CHLOR to describe a product that includes chlorhexidine or chlorine and, in many cases, includes antiseptic properties. The marks' suffixes – PREP and SHIELD, respectively – describe the functions of the products, i.e., to prepare skin for operation and to shield an insertion site from infection. *See In re Tower Tech Inc.*, 64 U.S.P.Q.2d 1314, 1316 (TTAB 2002) (explaining that a descriptive mark “immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used or is intended to be used” and finding the composite mark SMARTTOWER descriptive of “commercial and industrial cooling towers and accessories therefor, sold as a unit.”) [REDACTED]

[REDACTED]

[REDACTED]

2. Opposer's Marks Are in a Crowded Field

As reflected above, Opposer's marks coexist on the register and in the marketplace with many other marks that begin with, or use, CHLOR to indicate that the products offered thereunder include chlorhexidine or chlorine and, in many cases, include antiseptic properties. This is significant for, at least, three reasons. First, the third party use of CHLOR is evidence of the descriptiveness of this component of Opposer's marks. *See Zobmondo Entertainment, LLC*

⁸ Whether Registrant's marks as a whole are ultimately determined to be descriptive or suggestive is irrelevant. In either case, they are properly described as weak. *See AMF Inc. v. Sleekcraft Boats*, 204 U.S.P.Q. 808, 814 (9th Cir. 1979) (“In between lie suggestive marks which subtly connote something about the products. Although less distinctive than an arbitrary or fanciful mark and therefore a comparatively weak mark, a suggestive mark will be protected without proof of secondary meaning.”)

v. Falls Media, LLC, 94 U.S.P.Q.2d 1491 (9th Cir. 2010) (“Extensive use of a mark by third parties might indicate that the mark is merely descriptive of a given class of products.”)

Second, because CHLOR is descriptive and is frequently registered and used by third parties, prohibiting Applicant from registering and using the common term and prefix CHLOR would prevent Applicant from competing fairly by informing consumers of the nature of its products. *See Security Center, Ltd. v. First National Security Centers*, 225 U.S.P.Q. 373, 377 (5th Cir. 1985) (“The more users there are of a term, the more its protection in a given case would be commercially disruptive and unfair to competitors.”)

Third, when a mark, such as CHLOR, is registered and used by a number of third parties, consumers – particularly sophisticated consumers – are not likely to be confused between any two marks in the crowd. *In re The Lucky Company*, 209 U.S.P.Q. 422, 423 (TTAB 1980); *In re Broadway Chicken Inc.*, 38 U.S.P.Q.2d 1559, 1565-66 (TTAB 1996) (“Evidence of widespread third-party use, in a particular field, of marks containing a certain shared term is competent to suggest that purchasers have been conditioned to look to other elements of the marks as a means of distinguishing the source of goods or services in the field.”) This is true even if the third parties’ marks are used on products that do not directly compete. *See Jupiter Hosting Inc. v. Jupitermedia Corp.*, 76 U.S.P.Q.2d 1042, 1045-46 (N.D. Cal. 2004) (use of JUPITER by companies that “provide computer, technology and Internet-related products on or through the Web” rendered the mark weak; court refused to preliminary enjoin use of JUPITER HOSTING despite movant’s registration of JUPITER.)

Opposer claims that the third party use of record is irrelevant because Opposer uses the prefix CHLORA, not CHLOR or CHLORO. (Opposer’s Tr. Brief, p. 31.) This argument is unavailing for a number of reasons. Opposer admits that CHLORA references its products’ use

of the chlorhexidine molecule for its antiseptic qualities. (Opposer’s Tr. Brief., p. 31.) Thus, to consumers, CHLOR, CHLORA, and CHLORO – as used with products that have antiseptic qualities – are essentially equivalent. They all describe the products’ antiseptic qualities, just as NUTR and NUTRA both describe the nutrients contained in fertilizer-related products. *See Thompson-Hayward Chemical Co. v. Occidental Petroleum Corp.*, 172 U.S.P.Q. 501, 501-02 (TTAB 1971) (dismissing opposition to BEST NUTRA WET for fertilizers based on registration of NUTRA-SPRAY and NUTRA-PHOS for specialty fertilizer compositions and holding that opposer’s “aware[ness] of the use by others of marks beginning with the prefix ‘NUTR’ for similar products of others” and the fact that “the highly suggestive suffix ‘NUTR’ has been adopted by others” weighed against a likelihood of confusion). Also, Opposer is not the lone user of CHLORA in the medical field. For example, the registered marks CHLORAZENE – made of record by Opposer – and CHLORAG+ARD⁹ both use the CHLORA prefix for products in the medical field. (NOR 49; NOR 64; NOR 66; OX 80; OX 84.)

3. Opposer’s Marks Are Neither Strong Nor Famous

Opposer has not presented sufficient evidence to establish the strength or fame of its marks.

First, Opposer’s evidence of sales of its products offered under its marks is not evidence of fame absent proof tying the sales to use of the marks. *See Goodyear Tire and Rubber Co. v. Interco Tire Corp. (US Pats)*, 49 U.S.P.Q.2d 1705, 1720 (TTAB 1998) (“mere sales alone, even over an appreciable time period, do not suffice to establish acquired distinctiveness in and of

⁹



themselves”; \$56 million in sales not evidence of secondary meaning). Growth in sales may only be indicative of the popularity of the products, rather than recognition of the marks they bear. *In re Bongrain International (American) Corp.*, 13 U.S.P.Q.2d 1727, 1729 (Fed. Cir. 1990). Here, Opposer has not presented any evidence tying the volume of sales of CHLORAPREP products to the relevant buyer class’ recognition of the CHLORAPREP mark. On the contrary, any purported popularity of the CHLORAPREP product is likely because it was the first CHG-based antiseptic skin preparation in the U.S. (Opposer’s Tr. Brief, p. 7.) Likewise, Opposer’s own witness attributed CHLORAPREP products’ popularity to their effectiveness, not mark recognition. (Schultz Tr., 44:18-23, 45:3-19.)

Second, Opposer’s evidence of advertising and marketing spend and the number of “impressions” its online advertising has received are not probative of strength because each of these figures is presented without relevant context. *See Inter Ikea Sys. B.V. v. Akea, LLC*, 110 U.S.P.Q.2d 1734, 1738-39 (TTAB 2014) (“Although raw numbers of product sales and advertising expenses may have sufficed in the past to prove fame of a mark, raw numbers alone may be misleading. Some context in which to place raw statistics may be necessary (e.g., the substantiality of the sales or advertising figures for comparable types of products or services).”). Opposer has not presented any admissible evidence establishing whether its advertising spend or number of “impressions” are significant or modest in the medical device industry.¹⁰ Absent such context, the Board cannot accord this evidence any weight.

Third, Opposer has not made of record any examples of its online or journal advertising. Absent such evidence, the Board cannot assess the use of the CHLORAPREP mark in these advertisements to determine if they weigh in favor of Opposer’s claim of strength.

¹⁰ As set forth in the attached Appendix B, Creidenberg’s testimony comparing Opposer’s advertising expenditures to those of Opposer’s competitors is inadmissible.

Fourth, Opposer has only made of record one piece of advertising – a surgeon preference card – distributed after 2008. (OX 30.) Likewise, Opposer has not made of record any documents reflecting its attendance or promotion of CHLORAPREP at trade shows after 2009. Thus, at best, Opposer has presented evidence of strength and fame circa 2008-09, not as of the date Applicant filed its Applications.

Fifth, Opposer admits that at least some of its advertising efforts do not relate solely to the CHLORAPREP products but, instead, all of Opposer's products. For example, Opposer attended trade shows to promote all of its brands, not just CHLORAPREP. (Creidenberg Tr., 98:4-15.) Similarly, Opposer has re-dubbed the "ChloraPrep Reps" as the "CareFusion Reps" because they advertise "a much broader portfolio of products than they did when they only had ChloraPrep in their bag." (*Id.*, 261:14-23.) Accordingly, Opposer's advertising evidence must be discounted to the extent it incorporates amounts and energy spent advertising non-CHLORAPREP products. *See AS Holdings, Inc. v. H & C Milcor, Inc.*, 107 U.S.P.Q.2d 1829, 1838 (TTAB 2013) (discounting advertising expenditures because they included amounts spent to advertise products and marks not at issue in the dispute).

Sixth, as explained in greater detail in Appendix B, Opposer's evidence of purported unaided brand awareness of the CHLORAPREP mark is inadmissible hearsay and lacks foundation. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

See Beacon Mutual

Insurance Co. v. OneBeacon Insurance Group, 75 U.S.P.Q.2d 1409, 1413 (D.R.I. 2005), *citing Am. Assoc. for the Advancement of Science v. Hearst Corp.*, 206 U.S.P.Q. 605, 617 (D.D.C.

1980) (“secondary meaning is determined on the basis of *purchaser* perception . . . ‘The question is not whether the general public, but the *relevant buyer class* associates a name with a product or its source.’”) (emphases in original).

ii. The Parties’ Marks are Distinguishable in Sound, Appearance, Connotation, and Commercial Impression

When comparing Opposer’s and Applicant’s respective marks, it is critical to do so in light of the weakness of Opposer’s marks and, particularly, their CHLORA prefix. “[W]here a party chooses a trademark which is inherently weak, he will not enjoy the wide latitude of protection afforded the owners of strong trademarks. Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights.” *Safer Inc. v. OMS Investments Inc.*, 94 U.S.P.Q.2d 1031, 1045 (TTAB 2010) (holding that DEER-B-GON is not likely to be confused with DEER AWAY or DEER PROFESSIONAL for deer repellant), *citing Sure-Fit Products co. v. Saltzon Drapery Co.*, 117 U.S.P.Q 295, 296 (CCPA 1958). In such cases, the public will look to other portions of the marks and will not be confused unless the other portions are similar, even if the goods offered under the marks are identical or related. *See The Land-O-Nod Company v. Paulison*, 220 U.S.P.Q. 61, 66-67 (TTAB 1983) (“the addition of other matter to a merely descriptive or highly suggestive designation may result in the creation of a mark which is distinguishably different

therefrom so as to avoid confusion in trade”; CHIROPRACTIC and CHIRO-MATIC for mattresses not likely to be confused); *Knapp-Monarch Co. v. Poloron Products, Inc.*, 134 U.S.P.Q. 412, 414 (TTAB 1962) (THERMEX and THERM-A-JUG for insulated containers not likely to be confused; “while these marks both comprise the term ‘therm’, said term, which denotes heat, is highly suggestive of the nature of the goods of both parties, all of which are insulated against the transmission of heat”); *In Re Digirad Corp.*, 45 U.S.P.Q.2d 1841, 1845-46 (TTAB 1998) (DIGIRAY for electronic X-ray system and DIGIRAD for radiation sensors not likely to be confused); *The Wooster Brush Co. v. Prager Brush Co.*, 231 U.S.P.Q. 316, 318 (TTAB 1986) (POLY PRO and POLY FLO for paint brushes not likely to be confused; “the addition of other matter to a highly suggestive or descriptive designation, **whether such matter is equally suggestive or even descriptive**, may be sufficient to avoid confusion”) (emphasis added); *Water Pik, Inc. v. Med-Systems, Inc.*, 107 U.S.P.Q.2d 2095, 2109 (10th Cir. 2013) (SINUCLEANSE and SINUSENSE for sinus rinsing device not likely to be confused; “[g]iven the weakness of the SinuCleanse mark, the likelihood of confusion is small unless the challenged mark is very similar.”)

American Cyanamid Corp. v. Connaught Laboratories, Inc., 231 U.S.P.Q. 128 (2d Cir. 1986) is particularly instructive. There, the appellate panel reversed the trial court’s injunction against defendant’s use of the mark HIBVAX based on plaintiff’s rights in the mark HIB-IMUNE and, moreover, entered judgment for defendant. Both parties’ products were vaccines immunizing children against *Haemophilus influenza* type b, or, more informally, “hib.” *Id.* The court ruled that plaintiff could not appropriate for itself exclusive use of the generic prefix HIB. *Id.* at 129. Accordingly, “any likelihood of confusion between [the marks] . . . must be based on

a similarity between the suffixes ‘VAX’ and ‘IMUNE,’” which components the court found to be “totally different” and distinguishing despite their lack of distinctiveness. *Id.*

Accordingly, Opposer’s marks and Applicant’s marks are not likely to be confused because the only common element they share is the weak, descriptive CHLORA prefix. As the above cases establish, the sharing of a weak, descriptive prefix is insufficient to ground a finding of a likelihood of confusion. Opposer does not dispute that the respective suffixes of the parties’ marks— PREP and SHIELD, on the one hand, and DRAPE, DERM, ABSORB¹¹, and BOND, on the other – are dissimilar in sound, appearance, and connotation. Accordingly, the marks are distinguishable, highly suggestive marks.

Amongst the litany of cases Opposer cites in support of its contention that the parties’ marks are similar, it does not cite even one where the common element of the marks was descriptive or even highly suggestive. Instead, in each of these cases, the shared element was unquestionably strong. *See In re G.B.I. Tile and Stone Inc.*, 92 U.S.P.Q.2d 1366, 1367 (TTAB 2009) (common element was “distinctive” word CAPRI as used for various types of tiles); *In re Toshiba Medical Systems Corp.*, 91 U.S.P.Q.2d 1266, 1271 (TTAB 2009) (TITAN for various types of medical devices; “to the extent that it is laudatory, [it] is only slightly laudatory, and it is not entitled to only a narrow scope of protection”); *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 U.S.P.Q.2d 1689, 1692 (Fed. Cir. 2005) (common term VEUVE is “strong” and “distinctive”); *In re Chatam Int’l Inc.*, 71 U.S.P.Q.2d 1944, 1944-45 (Fed. Cir. 2004) (GASPAR and GASPAR’S in the field of alcoholic beverages); *Hewlett-Packard Co. v. Packard Press Inc.*, 62 U.S.P.Q.2d 1001, 1002 (Fed. Cir. 2002) (PACKARD for services in the computer industry.) Thus, the facts of these cases are clearly inapposite to the facts at bar.

¹¹ Unlike Applicant’s other marks, CHLORABSORB’s prefix is CHLOR, not CHLORA.

In sum, this factor weighs against a finding of a likelihood of confusion.

iii. The Products Offered Under the Parties' Marks Are Advertised in Unrelated Channels

In determining a likelihood of confusion, the Board has considered the similarity of the channels in which the parties' products are advertised. *Triumph Machinery Company v. Kentmaster Manufacturing Company Inc.*, 1 U.S.P.Q.2d 1826, 1828-29 (TTAB 1987). *See also Archer Daniels Midland Co. v. Chocolates A La Carte, Inc.*, 2000 WL 158721, at *7, n.14 (TTAB May 13, 1999) ("the parties exhibit at different trade shows and advertise in different trade publications, directed to different target audiences.")

Here, there is no doubt that Opposer and Applicant advertise the products offered under their respective marks through different channels and by different means. [REDACTED]

[REDACTED] (McGuire Tr., 254:17-256:2.) Opposer, on the other hand, has a robust advertising practice. (Opposer's Tr. Brief, pp. 9-13.) Furthermore, both parties' promotional efforts – whether conducted in-person, like Applicant, or through print, internet, and other means, like Opposer – clearly identify their respective sources, such that consumer confusion is unlikely. (McGuire Tr., 255:3-15; Creidenberg Tr., 261:14-262:2; NOR 61, Ex. D1, Response to Interrogatory No. 15.)

Thus, the parties' different methods and channels for advertising their respective marks weighs against a likelihood of confusion.

iv. The Products Offered Under the Parties' Marks are Sold to Sophisticated Consumers and Under Other Conditions Unlikely to Result in Confusion

Opposer's trial brief omits any discussion of the sophistication of the relevant consumers, the retail price of the parties' products, and other conditions mitigating against a likelihood of

confusion. The Board should view this as a tacit admission that this critical *du Pont* factor weighs in Applicant's favor.¹²

In this case, it is clear that the circumstances under which the parties' products are purchased mitigate against a likelihood of confusion. The parties' products are not available to the general public but, instead are sold exclusively to medical professionals, an undeniably sophisticated buyer class. The Board has previously held that medical equipment "would be selected with great care by purchasers familiar with the source or origin of the products. [citation omitted.] Buyers of the parties' goods, as well as potential customers for the products, plainly are highly educated, sophisticated purchasers who know their equipment needs and would be expected to exercise a great deal of care in its selection." *Hewlett-Packard Co. v. Human Performance Measurement Inc.*, 23 U.S.P.Q.2d 1390, 1396 (TTAB 1991). *See also Aries Systems Corp. v. World Book Inc.*, 26 U.S.P.Q.2d 1926, 1932 (TTAB 1993) ("doctors, clinicians, medical researchers and other medical professionals [are] well-educated and highly-trained individuals . . . apt to be careful and discriminating.")

Furthermore, Opposer's and Applicant's products are not only purchased by sophisticated by medical professionals but are, additionally, purchased according to processes and procedures that are time- and labor-intensive and minimize any possible opportunity for confusion. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] (Creidenberg Tr. 261:8-262:2; Creidenberg. Disc. 165:14-166:19, 177:23-179:12.)

¹² Failure to consider the sophistication of the relevant buyer class has been grounds for reversing a Board's decision to sustain an opposition. *See Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 21 U.S.P.Q.2d 1388, 1392 (Fed. Cir. 1992), *citing Pignons S.A. de Mecanique de Precision v. Polaroid Corp.*, 212 U.S.P.Q. 246, 252 (1st Cir. 1981) (the Board "failed to give due weigh to countervailing *du Pont* factors, such as the sophistication of the consumers . . . Where the purchasers are the same, their sophistication is important and often dispositive because '[s]ophisticated consumers may be expected to exercise greater care.'")

Opposer's own witness describes the methodical process by which hospitals, for example, make purchasing decisions, which includes committee-assessment and study and evaluation of the relevant studies and literature. (Schultz Tr., 8:20-9:12, 11:16-25, 12:20-13:13.)

Additionally, there is no dispute that Opposer's and Applicant's products at issue are typically purchased in bulk at a significant price. The Board has repeatedly held that "there is always less likelihood of confusion where goods are expensive and purchased after careful consideration." *Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc.*, 220 U.S.P.Q. 786, 790 (TTAB 1983).

Finally, as noted above, the parties' respective promotional efforts clearly identify their respective source, i.e., when either Opposer and Applicant propose that a hospital or distributor purchase its respective product, there is no ambiguity as to whose product it is.

In sum, the sophistication of the buyer class, the expense of the products, and the circumstances under which purchasing decisions are made weigh heavily against a finding of a likelihood of confusion. In circumstances such as those at bar where the parties' mark bear the same first word or element, both the Board and the Federal Circuit have allotted significant weight to the condition under which purchases are made. *See Industrial Nucleonics Corp. v. Hinde*, 177 U.S.P.Q. 386, 387 (CCPA 1973) (the "differences [in ACCURA-FLO and ACCURAY] might not be sufficient if we were dealing with off-the-shelf items purchased by all manner of people. But we think the fact which fully justifies the board's conclusion in this case is that both parties sell their goods to discriminating purchasers under conditions calculated to insure care in discerning the source or origin of the goods"); *Safer*, 94 U.S.P.Q.2d at 1044-45 (sophistication of consumers weighed against a likelihood of confusion between DEER-B-GON and DEER AWAY); *Digirad*, 45 U.S.P.Q.2d at 1844 (DIGIRAY and DIGIRAD not likely to be

confused because of, in part, “sophistication of [relevant purchasers of the parties’ goods], the care with which the products are purchased, and the expense thereof.”)

v. Applicant Selected its Marks in Good Faith

Opposer’s attempts to paint Applicant or Entrotech as a bad actor are not only belied by the evidence of record, they are largely irrelevant. Instead, the only intent of Applicant relevant to the issues before the Board is that relating to its selection or adoption of its marks and any intent to confuse. Opposer has not identified any case law or other authority allowing the Board to consider other alleged acts of bad faith or unfair competition when considering the issue of likelihood of confusion. Likewise, the thirteenth *du Pont* factor does not open the door for mudslinging regarding Applicant’s alleged business tactics but, instead, is limited to “evidence of applicant’s bad faith adoption of his mark.” *Edom Laboratories, Inc. v. Lichter*, 102 U.S.P.Q.2d 1546, 1553 (TTAB 2012).¹³ Moreover, Opposer cannot draw any reasonable nexus between Applicant’s alleged bad acts and its adoption of its marks or the likelihood of confusion. The Board should see Opposer’s allegations for what they are, namely, an inappropriate attempt to bias the Board against Applicant.

Applicant’s intent behind adopting its marks at issue is clear: it intended to select marks that indicated each of its product’s antiseptic properties and general function. Applicant endeavored to accomplish this by, per the established naming convention, using the prefix CHLORA to indicate the former and a short descriptive term to indicate the latter. Applicant’s marks follow the precedent of other marks used for products containing chlorhexidine and, more generally, chlorine, many of which have antiseptic properties. Moreover, Applicant had no knowledge of Opposer’s alleged consideration of the name CHLORADRAPE for the product

¹³ Opposer itself admits that “[t]his is not a lawsuit alleging unfair competition. Indeed the Board does not have jurisdiction over such issues.” (Opposer’s Tr. Brief, Appendix B, p. 3.)

Applicant was developing¹⁴, and Opposer has no documentary evidence reflecting anything to the contrary.

Opposer intimates that Applicant's knowledge of Opposer's CHLORAPREP mark is tantamount to Applicant selecting its marks with a bad faith intent to confuse. This is incorrect as a matter of law.¹⁵ *See Sweats Fashions, Inc. v. Pannill Knitting Co., Inc.*, 4 U.S.P.Q.2d 1793, 1797-98 (Fed. Cir. 1987) ("[a]n inference of 'bad faith' requires something more than mere knowledge of a prior similar mark.") Here, Opposer cannot point to any other facts beyond Applicant's mere knowledge of the CHLORAPREP mark establishing that Applicant selected its marks with a bad faith intent to confuse. Opposer's argument might carry more weight if CHLOR and CHLORA were not consistently used in product names to indicate their antiseptic properties. Also, there is no showing that Applicant is trying to pass off its products as Opposer's. On the contrary, the parties' respective packaging and branding – packaging and branding for which Applicant has received FDA approval – is unquestionably distinguishable and different. (McGuire Tr., 203:3-204:11, 222:5-223:22; AX 30; AX 41; Creidenberg Tr., 275:18-277:1; OX 60.)

Applicant's witnesses have testified that Applicant does not want its products offered under its marks at issue to be associated with Opposer or its products. (McGuire Tr., 262:14-17.)

¹⁴ Opposer does not allege that it ever considered or disclosed to Applicant the marks CHLORADERM, CHLORABOND, or CHLORABSORB.

¹⁵ Even if Applicant "copied" Opposer's CHLORA prefix, (which it did not) that is irrelevant absent a showing that Applicant did so with a bad faith intent to confuse. *See A & H Sportswear, Inc. v. Victoria's Secret Stores, Inc.*, 57 U.S.P.Q.2d 1097, 1114-15 (3d Cir. 2000) ("a defendant's mere intent to copy, without more, is not sufficiently probative of the defendant's success in causing confusion to weigh such a finding in the plaintiff's favor; rather, defendant's intent will indicate a likelihood of confusion only if an intent to confuse consumers is demonstrated via purposeful manipulation of the junior mark to resemble the senior's.") Of course, Opposer has not elicited any evidence of copying. However, the point stands that Applicant's alleged "copying" of this descriptive element of Opposer's CHLORAPREP mark, absent additional evidence of bad faith, is nothing more than Applicant availing itself of a descriptive term available to anyone. *See* 4 McCarthy on Trademarks and Unfair Competition § 23:122 (4th ed.) ("evidence that a junior user exactly copied unprotected descriptive, generic or functional public domain words or shapes does not prove any legal or moral wrongs.")

As noted above, Applicant's products are an improvement over Opposer's products in many respects, including, but not limited to, superior antimicrobial performance and adhesive ability. Naturally, Applicant's efforts to distinguish itself in the marketplace as a purveyor of superior products would be hindered if consumers associated Applicant with Opposer. Moreover, the fact that Applicant has not abandoned its Applications and intent to use its marks in light of the significant bad press related to CHLORAPREP is also indicative of Applicant's good faith belief that its marks are not likely to be confused with Opposer's. (*Id.*, 164:3-165:3.)

Opposer cannot adopt weak marks composed of two descriptive components and then complain that Applicant has intentionally attempted to take advantage of consumer recognition of Opposer's marks because Applicant's marks are also composed of two descriptive components. Instead, as noted above, this is precisely the risk Opposer bears when it adopts a weak mark.

In sum, Applicant's good faith adoption of its marks weighs against a finding of a likelihood of confusion.

vi. Opposer's Marks Do Not Constitute a Family of Marks

Opposer has not established that it owns a family of CHLORA marks, much less ownership of a family of marks prior to Applicant's constructive first use of its marks. *See Citigroup Inc. v. Capital City Bank Group Inc.*, 94 U.S.P.Q.2d 1645, 1647 (TTAB 2010) ("To establish a family of marks, opposer must prove that, prior to applicant's first use of its mark, opposer established its family of marks.") "A family of marks is a group of marks having a recognizable common characteristic, wherein the marks are composed and used in such a way that the public associates not only the individual marks, but the common characteristic of the family, with the trademark owner." *J&J Snack Foods Corp. v. McDonald's Corp.*, 18 U.S.P.Q.2d 1889, 1891 (Fed. Cir. 1991). The claimant "must demonstrate that the marks

asserted to comprise the family, or a number of them, have been used and advertised in promotional material or in everyday sales activities in such a manner as to create common exposure and thereafter recognition of common ownership based upon a feature common to each mark.” *Nike Inc. v. WNBA Enterprises LLC*, 85 U.S.P.Q.2d 1187, 1194 (TTAB 2007).

Opposer has not submitted any evidence of any effort to promote its CHLORAPREP and CHLORASHIELD marks or products offered thereunder in a manner sufficient to create consumer recognition of common ownership of the marks based upon both marks’ uses of the CHLORA prefix. In fact, Opposer admits that its use of CHLORASHIELD is still in its infancy. (Creidenberg Tr., 270:13-18.) Moreover, the Board has held that two marks cannot constitute a “family.” *See Land-O-Nod*, 220 U.S.P.Q. at 66 (“even if there were evidence of such use and promotion together, the most that could be said would be that opposer had a ‘couple’ of marks, not a ‘family.’”))

In sum, the Board should not find that Opposer owns a family of marks or any rights in the CHLORA prefix separate and apart from its CHLORAPREP and CHLORASHIELD marks in their entireties.

VI. SUMMARY

Applicant respectfully submits that, after carefully considering all of the admissible evidence in light of the relevant *du Pont* factors, it is clear that that Opposer has not established a likelihood of confusion. In particular, the evidence shows the following:

- Opposer’s CHLORAPREP and CHLORASHIELD marks are weak marks entitled to only narrow protection;
- There is extensive third party use of the terms CHLOR, CHLORA, and CHLORO to indicate a product’s antiseptic qualities in the marketplace;

- Opposer's CHLORAPREP and Arrows' CHLORAG+ARD marks have co-existed concurrently in the marketplace for almost five years without any actual confusion;
- The Parties' marks are materially different in appearance, sound, connotation and commercial impression, especially given the weakness of Opposer's marks;
- The Parties' marks are advertised in different and distinguishable manners and channels;
- The buyer class for the products are sophisticated medical professionals who purchase products according to time- and labor-intensive procedures;
- The products are expensive;
- Applicant acted in good faith in adopting each of its marks; and
- Opposer does not own a family of marks.

In light of all the admissible evidence of record, Opposer has not and cannot prove that an appreciable number of members of the relevant buyer class will be confused. *Perini Corp. v. Perini Construction, Inc.*, 16 U.S.P.Q.2d 1289, 1293 (4th Cir. 1990).

For the foregoing reasons, ELS respectfully requests that this Board dismiss Opposer's Combined Opposition and remand application Serial Nos. 85/499,349 for the mark **CHLORADERM**; 85/499,345 for the mark **CHLORABSORB**; 85/499,337 for the mark **CHLORABOND**; and 85/499,332 for the mark **CHLORADRAPE** to the assigned Examining Attorney for issuance of Notices of Allowance.

Submitted: October 5, 2015

SHEPPARD, MULLIN, RICHTER, & HAMPTON LLP

By: /s/ Lisa M. Martens
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ENTROTECH LIFE SCIENCES, INC.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of application Serial Nos.:

85/499,349 for the mark **CHLORADERM**
85/499,345 for the mark **CHLORABSORB**
85/499,337 for the mark **CHLORABOND**
85/499,332 for the mark **CHLORADRAPE**

Filed on December 19, 2011

Published in the *Official Gazette* on May 29, 2012

CAREFUSION 2200, INC.,

Opposer,

v.

ENTROTECH LIFE SCIENCES, INC.,

Applicant.

Combined Opposition Proceeding No.: 91-206,212

APPENDIX A

**APPLICANT’S RESPONSE TO OPPOSER’S OBJECTIONS TO CERTAIN EXHIBITS
SUBMITTED UNDER APPLICANT’S NOTICES OF RELIANCE**

Applicant Entrotech Life Sciences, Inc. (“Applicant”) hereby responds to Appendix B of Opposer Carefusion 2200, Inc.’s Trial Brief objecting to Exhibits E1–E6, J1–J3, and I1 as submitted with Applicant’s Notices of Reliance.

A. Applicant’s Exhibits E1-E6 relating to Opposer’s CHLORASHIELD Registration for a “Surgical Incise Drape”

Opposer’s application to register CHLORASHIELD for a “surgical incise drape” is plainly relevant to the parties’ dispute and Applicant’s evidence reflecting the same should not be stricken. Opposer claims that it disclosed to Applicant that, in the event Opposer commercialized Applicant’s surgical incise product, it would market it under the name

CHLORADRAPE. Applicant, however, has no recollection of Opposer ever disclosing the name CHLORADRAPE to it. Instead, Applicant recalls Opposer disclosing CHLORASHIELD as a potential name of the product, which recollection is supported by Opposer's filing of its application to register CHLORASHIELD for a "surgical incise drape" concurrent with the parties' dealings. Thus, this evidence – Opposer's application to register CHLORASHIELD – has a tendency to make Opposer's claims that it disclosed the name CHLORADRAPE to Applicant and intended to commercialize Opposer's product as CHLORADRAPE less probable than these claims might be without this evidence, thereby satisfying Fed.R.Evid. 401.

Opposer did not render its application to register CHLORASHIELD irrelevant to the parties' dispute for all purposes simply by voluntarily surrendering the registration resulting therefrom. To hold otherwise would essentially allow Opposer to whitewash the past to the significant prejudice of Applicant. Also, contrary to Opposer's representation otherwise, the Board never deemed Opposer's application to register CHLORASHIELD moot. Instead, it deemed Applicant's "motion to compel written discovery or deposition testimony regarding this registration and/or any common law rights associated with the CHLORASHIELD mark" moot. (Dkt. No. 41.) Notably, in its motion to compel, Applicant sought an order of the Board compelling Opposer to respond to discovery related to its alleged bona fide intent to use and actual use of CHLORASHIELD for surgical incise drapes. (Dkt. No. 39.) As noted above, Applicant has made Opposer's application to register CHLORASHIELD of record as it relates to Opposer's claim that Applicant selected the mark CHLORADRAPE in bad faith, not for any of the reasons at issue in Applicant's motion to compel.

Accordingly, Opposer's objections to Exhibits E1-E6 or, at least, E1, should be overruled.

B. Applicant's Exhibits J1-J3 and I1 relating to the DOJ Investigation and Settlement

The Department of Justice's ("DOJ") investigation of Opposer's alleged marketing tactics and improper promotion of its CHLORAPREP product is relevant to the alleged strength of Opposer's CHLORAPREP mark, specifically the goodwill associated with the mark, and Applicant's lack of intent to associate itself with Opposer. Opposer touts the strength and recognition of the CHLORAPREP mark and claims that Applicant adopted the marks at issue "with the intent of capitalizing on the renown of CareFusion's ChloraPrep products." (Opposer's Trial Brief, p. 37.) Applicant's evidence shows that this is not the case.

Opposer's alleged strength and goodwill in its CHLORAPREP mark has been damaged as a result of the DOJ investigation. Applicant's interests would not be best served by attempting to associate itself with a brand with a tarnished goodwill. Quite the contrary. If Applicant believed that its marks may be associated with Opposer and Opposer's CHLORAPREP product, Entrotech would have abandoned its marks to avoid any negative association.

Finally, Applicant is not accusing Opposer of unfair competition and therefore Opposer's cite to *Paramount Pictures Corp. v. White*, 31 U.S.P.Q.2d 1768, 1171 n. 5 (TTAB 1994) is inapplicable.

Dated: October 5, 2015

Respectfully submitted,

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By

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APPENDIX B

APPLICANT’S OBJECTIONS TO CERTAIN EVIDENCE OFFERED BY OPPOSER

Applicant Entrotech Life Sciences, Inc. (“Applicant”) hereby objects to certain evidence offered by Opposer Carefusion 2200, Inc. (“Opposer”).

A. Applicant’s Motions to Strike (Dkt Nos. 58-60)

Applicant renews the objections it raised in its motions to strike filed on May 1, 2015 (Dkt Nos. 58-59) and incorporates herein by reference the reply brief it filed on September 21, 2015 relating to the discovery depositions of Dr. John S. Foor and Mr. John Halsey. (Dkt. No. 83.)

Opposer neither substantively nor timely responded to Applicant’s Motion to Strike Opposer’s Notice of Reliance Offering in Evidence Certain Printed Publications and a

Standalone Bibliography, also filed on May 1, 2015. (Dkt. No. 60.) Instead, on June 25, 2015, well after its response brief was due and outside of its testimony period, Opposer filed a substitute notice of reliance (Dkt. No. 73) purportedly correcting its original notice of reliance at issue in Opposer's motion to strike. (Dkt. No. 42.)

The Board should grant Applicant's motion to strike because Opposer failed to timely respond to Applicant's motion to strike and, in fact, never substantively responded to it. Accordingly, it should be considered conceded. *See* 37 C.F.R. 2.127(a) ("When a party fails to file a brief in response to a motion, the Board may treat the motion as conceded"); *Newhoff Blumberg Inc. v. Romper Room Enterprises, Inc.*, 193 U.S.P.Q. 313, 315 (TTAB 1976) ("We find that petitioner's failure to file a timely responsive brief to respondent's motion for judgment under Rule 2.132(b) conceded it. Respondent's motion under Rule 2.132(b) is granted as having been conceded.")

Also, the Board should not allow Opposer's substitute notice of reliance into evidence. Opposer's substitute notice of reliance was filed outside of its initial testimony period, and, thus, is untimely. *See* 37 CFR § 2.123(l) ("Evidence not obtained and filed in compliance with these sections will not be considered"); *Baseball America Inc. v. Powerplay Sports Ltd.*, 71 U.S.P.Q.2d 1844, 1846, n.8 (TTAB 2004) (evidence submitted outside of applicant's assigned testimony period "shall be given no consideration.") Furthermore, Opposer's substitute notice of reliance includes six publications (nos. 19-24) not included in its initial notice of reliance. Thus, as the very least, the Board should strike publication nos. 19-24 for being untimely.

Lastly, the publications Opposer seeks to make of record through its substitute – and initial – notice of reliance are irrelevant to the strength or fame of Opposer's CHLORAPREP mark. The publications, at best, simply show that Opposer's CHLORAPREP product has been

referred to or the subject of literature in the medical field. None of the publications relates to the fame or strength of the CHLORAPREP mark or, for that matter, the CHLORAPREP product. Mention of the CHLORAPREP mark or product in these publications is not tantamount to a showing of consumer recognition of the CHLORAPREP mark, which is the relevant inquiry when determining a mark's strength. In fact, some of the publications (e.g., nos. 3-5) do not even mention Opposer's CHLORAPREP product.

In sum, the Board should grant Applicant's motions to strike (Dkt Nos. 58-60) and exclude from evidence Opposer's substitute notice of reliance. (Dkt No. 73.)

B. Trial Testimony of Carol Schultz

The Board should strike from the record Opposer's rebuttal testimony deposition of Carol Schultz regarding the recognition of CHLORAPREP by medical professionals. Such testimony constitutes improper rebuttal testimony and should be stricken or excluded from the record. The Board should also strike from the record any testimony of Schultz regarding likelihood of confusion between Applicant's marks and the CHLORAPREP mark as such testimony is not only improper rebuttal testimony, but is well beyond the scope of Schultz's rebuttal testimony as disclosed by Opposer and is irrelevant and lacks foundation as a matter of law.

1. The Board Should Strike Schultz's Testimony Regarding the Recognition of CHLORAPREP By Medical Professionals

In its rebuttal disclosures and notice of deposition for Schultz, Opposer stated that Schultz "will rebut testimony provided by Jim McGuire regarding recognition of the ChloraPrep brand by medical professionals." (Declaration of Lisa Martens ("Martens Decl.") ¶ 2-3, Exs. A and B.) At the outset of Opposer's deposition of Schultz, Applicant objected to the deposition as improper rebuttal testimony, and the deposition proceeded subject to that objection. (Trial Testimony of Carol Schultz ("Schultz Tr."), 5:14-23.) Schultz proceeded to testify regarding her

and the medical profession's recognition of CHLORAPREP, including, but not limited to, the following testimony:

- her familiarity with CHLORAPREP and its properties (*Id.*, 10:14-19);
- whether she knew who manufactured CHLORAPREP and how she recognized the CHLORAPREP product (*Id.*, 12:1-19);
- her familiarity with CHLORAPREP marketing materials (*Id.*, 14:22-15:11, 16:7-14);
- physicians' experience with CHLORAPREP and whether they "liked" it (*Id.*, 17:19-18:4)
- her hospital's preference for CHLORAPREP (*Id.*, 19:1-4);
- advertisements for and demonstrations of CHLORAPREP presented at the Association of Professionals in Infection Control meetings (*Id.*, 20:14-19);
- medical practitioners' recognition of the name CHLORAPREP (*Id.*, 22:10-23:17);
- awareness of allergic reactions to CHLORAPREP product and issues with the product's lack of adhesiveness (*Id.*, 24:21-26:21);¹ and
- the hospital staff's familiarity with CHLORAPREP. (*Id.*, 27:10-28:20.)

"Opposer may not make of record during its rebuttal testimony period evidence that should have been part of its case in chief; in the event that applicant submits evidence during its trial period, any rebuttal evidence submitted by opposer must be confined to that which denies, explains or discredits applicant's case." *Skincode AG v. Skin Concept AG*, 109 U.S.P.Q.2d 1325, 1330, n.6 (TTAB 2013). *See also Wet Seal Inc. v. FD Management Inc.*, 82 U.S.P.Q.2d 1629, 1632 (TTAB 2007) (rebuttal evidence was not submitted for the proper purpose of denying, explaining or discrediting applicant's case but instead was clearly an attempt by opposer to strengthen its case-in-chief); *AQFTM, Inc. v. Austinuts, Inc.*, 2009 TTAB LEXIS 528, at *4-7 (TTAB Aug. 6, 2009) (opposer's third-party registrations showing relatedness of goods could have been submitted during its case-in-chief and are not proper rebuttal; "There is no question

¹ Notably, this testimony is outside the scope of the subject matter for which Ms. Schultz was designated. Consequently, it should be excluded pursuant to 37 C.F.R. § 2.123(e)(3).

that opposer did address the issue of the relatedness of the goods during its case-in-chief. As one of the primary factors in determining likelihood of confusion, it is reasonable that, as in this case, both parties would present evidence and testimony on this issue unless it was admitted. There is also no reason why this evidence could not have also been submitted by opposer during its case-in-chief and it would have been relevant and appropriate. Opposer has not adequately explained how its rebuttal evidence is more than mere supplementation of its record.”)

In *The Ritz Hotel Limited v. Ritz Closet Seat Corp.*, 17 U.S.P.Q.2d 1466 (TTAB 1990), the Applicant objected to the testimony depositions of three witnesses. The opposer claimed that those witnesses testified as to their opinions concerning the likelihood of damage to the opposer in order to discredit the testimony of the applicant who stated that it was her opinion that applicant’s use of the mark had not caused any damage to the opposer - in essence, testifying that there was no likelihood of confusion. The Board found that the testimony of the witnesses should have been introduced as part of the case-in-chief because (1) the question of damage relates to opposer’s standing to be heard, which is a threshold matter, and (2) the opposer introduced similar testimony during its case-in-chief, so additional testimony related to the same subject matter would have little effect on the question of likelihood of confusion. *Ritz*, 17 U.S.P.Q.2d at 1469.

Here, the testimony offered by Schultz regarding the recognition of CHLORAPREP by medical professionals constitutes improper rebuttal testimony. Schultz’s testimony as to her familiarity with CHLORAPREP and the purported recognition of CHLORAPREP in the medical community serves no other purpose than to bolster Opposer’s arguments in its case-in-chief regarding the strength and fame of the CHLORAPREP mark, both of which are relevant to demonstrating a likelihood of confusion. Also, as in the *Ritz* case cited above, Shultz’s

testimony relates to the same subject matter as testimony that was introduced during Opposer's case-in-chief.² Accordingly, Schultz's testimony regarding the recognition of CHLORAPREP by medical professionals should have been introduced by Opposer during its case-in-chief and, thus, constitutes improper rebuttal testimony.

2. The Board Should Strike Schultz's Testimony Regarding the Similarity Between CHLORAPREP, CHLORASHIELD, CHLORASCRUB, and Applicant's Marks

At her testimony deposition, Schultz opined as to the similarity of CHLORAPREP, on one hand, and CHLORASHIELD, CHLORADRAPE, CHLORABOND, and CHLORASCRUB, on the other hand. (Schultz Tr., 30:10-31:15.) Applicant immediately moved to strike this testimony. (*Id.*, 31:16.)

Clearly, the alleged similarity of CHLORAPREP and Applicant's marks is an element of Opposer's case-in-chief. Additionally, Opposer submitted evidence purportedly supporting said alleged similarity in its case-in-chief. Accordingly, Schultz's testimony constitutes improper rebuttal testimony and should be excluded as such.

Furthermore, Schultz's testimony is well outside of the limited scope for which she was designated, that is, to "rebut testimony provided by Jim McGuire regarding recognition of the ChloraPrep brand by medical professionals." Accordingly, Schultz's testimony should be excluded pursuant to 37 C.F.R. § 2.123(e)(3), as well.

Finally, Schultz's testimony is irrelevant and lacks foundation as a matter of law. Schultz, a lay witness, is not qualified to testify to any ultimate issues of trademark law, including whether Applicant's marks are likely to be confused with Opposer's marks. *See*

² Schultz's testimony did not specifically contradict any testimony of McGuire regarding the recognition, or lack thereof, of CHLORAPREP by medical professionals.

Sunnen Products Co. v. Sunex International Inc., 1 U.S.P.Q.2d 1744, 1746, n.8 (TTAB 1987) (“Opposer's interrogation of its witnesses on questions pertaining to ultimate issues of trademark law in this proceeding (e.g., likelihood of confusion, absence of evidence of actual confusion) were impermissibly leading and were also objectionable on the ground that the witnesses were wholly unqualified to give opinion testimony on these issues of trademark law . . . hence, the greater part of the witnesses’ responses on the indicated pages have been given no weight in our evaluation of the issues”); *The Mennen Co. v. Yamanouchi Pharmaceutical Co., Ltd.*, 203 U.S.P.Q 302, 305 (TTAB 1979) (referring to “long-held view” that “the opinions of witnesses, including those qualified as expert witnesses, on the question of likelihood of confusion are entitled to little if any weight and should not be substituted for the opinion of the tribunal charged with the responsibility for the ultimate opinion on the question.”) Schultz’s testimony is especially subject to exclusion given Schultz’s affiliation with Opposer and the fact that she was paid to testify. (Schultz Tr., 32:18-35:4, 35:13-39:24.) *See Medtronic, Inc. v. Medical Devices, Inc.*, 204 U.S.P.Q 317, 325 (TTAB 1979) (“Apart from the fact that a good number of these witnesses were now, or at one time, consultants for or affiliated with opposer in one capacity or another, thereby rendering their comments somewhat unreliable, the expressions of opinion of witnesses, including those considered to be experts in a particular field, as to whether or not the marks involved in any given proceeding are or are not so similar as to cause a likelihood of confusion in trade is not binding upon the tribunals of the Patent and Trademark Office or the courts.”)

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C. Trial Testimony of Jan Creidenberg

The Board should strike from the record the following testimony of Opposer's witness Jan Creidenberg made at his trial deposition [REDACTED]

[REDACTED]:

[REDACTED]

(Trial Testimony of Jan Creidenberg ("Creidenberg Tr."), 126:14-127:9.)

Creidenberg's testimony lacks foundation and should be stricken from the record or, at least, accorded little weight. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] Consequently, Creidenberg's testimony is not "rationally based on the witness' perception," per Fed.R.Evid. 701, and should be stricken or accorded little weight. *See, e.g., Specialty Brands, Inc. v. Spiceseas, Inc.*, 220 U.S.P.Q. 73, 74, n.4 (TTAB 1983) ("opposer's senior vice president of marketing and sales

testified that a survey conducted for opposer showed that ‘SPICE ISLANDS’ products outsell all other premium spice brands. No supporting documentation was adduced to support this statement and we find it to be unreliable hearsay. Similarly, the statements as to specific sales and advertising figures are subject to challenge in that the affiant did not state the means by which the sales and advertising figures were obtained.”)

D. Exhibits OX 18-22

The Board should exclude or strike Opposer's exhibits OX 18-22 and any testimony of Creidenberg relating thereto because they constitute inadmissible hearsay and lack foundation.

A series of horizontal black bars of varying lengths, representing redacted text. The bars are arranged in a list-like fashion, with some bars starting at the left margin and others indented. There are 15 bars in total. The lengths vary significantly, with some bars spanning almost the entire width of the page and others being much shorter. The bars are solid black and have a uniform thickness.

[REDACTED]

[REDACTED]

[REDACTED]. *See Corporacion Habanos S.A. v. Guantanamera Cigars Co.*, 102 U.S.P.Q.2d 1085, 1092 (TTAB 2012) (“[b]ecause there is no information about how the surveys were conducted or how many persons participated in the surveys, or even if they were conducted scientifically in accordance with established survey practices, opposer's hearsay objection is sustained to the extent that it is directed to the results of the survey; we have not considered the survey results for the truth of any matter asserted therein”); *Cent. Garden & Pet Co. v. Dockosil Mfg. Co.*, 108 U.S.P.Q.2d 1134, 1138, n.9 (TTAB 2013) (“a survey cannot normally be submitted in evidence without the foundational testimony (and an opportunity for cross-examination) of the expert who designed and directed the survey and drew the reported conclusions”); *Richardson-Merrell Inc. v. Inka Cosmetic S.A.*, 211 U.S.P.Q. 919, 920, n.3 (TTAB 1981) (“Opposer has offered into evidence a market research study done at opposer's request in order to show that a large percentage of consumers are aware of ‘LAVORIS’ mouthwash and gargle. Applicant has objected to the introduction of the survey on the ground of hearsay. Since the deponent concedes he had nothing to do with the preparation of the survey, the Board is of the view that applicant's objection is well taken”); *Opuka-Boateng v. State of Cal.*, 95 F.3d 1461, 1471 (9th Cir. 1996) (“Ingham's testimony regarding the results of the poll, if offered for its truth, constituted inadmissible hearsay, for he testified as to what the supervisor who conducted the poll told him the employees said when they were asked about the possibility of accommodating Opuku–Boateng's religious beliefs.”)

[REDACTED]

[REDACTED]

[REDACTED]

E. Exhibit OX 23

Opposer's exhibit OX 23 is inadmissible hearsay and is irrelevant and must be excluded.

[REDACTED]

[REDACTED]

[REDACTED] Evidence based on hearsay is inadmissible as evidence. Fed.R.Evid. 802.

Hearsay is an out of court statement that is offered for the truth of the matter asserted therein.

Fed.R.Evid. 801. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

³ At the very least, the Board should afford little weight to the survey results and Creidenberg's testimony related thereto. *See Alberto-Culver Co. v. F.D.C. Wholesale Corp.*, 16 U.S.P.Q.2d 1597, 1601 (TTAB 1990) (applicant failed to timely object to introduction of survey results into evidence, nevertheless, "[w]e have, of course, taken into consideration that Mr. McAuley did not himself prepare the survey and that his testimony concerning the survey was, basically, that of one who had read the survey rather than one who was expert in designing survey questions and interpreting survey results.")

[REDACTED]

[REDACTED]. *See In re Bongrain International (American) Corp.*, 13 U.S.P.Q.2d 1727, 1729 (Fed. Cir. 1990) (sales may only be indicative of the popularity of the products, rather than recognition of the marks they bear.) [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

F. Exhibit OX 79

The Board should exclude or strike Opposer's exhibit OX 79 and any testimony of Jennifer Raeder-Devens relating thereto because they constitute inadmissible hearsay and lack foundation.

OX 79 is a chart entitled "Third Party Competitors" which lists each of Applicant's marks and, below each, a chart of third party products purportedly competing with the products offered under Applicant's marks. Attached to this document are various internet printouts reflecting the products listed in the charts.⁴

The chart is inadmissible hearsay to the extent it is used to establish that the products listed therein compete with the products offered under Applicant's marks. It is an out-of-court statement offered for the truth of the matter asserted therein, and, thus, is inadmissible under Fed.R.Evid. 801 and 802. Likewise, Raeder-Devens, as an employee of Opposer, not Applicant,

⁴ Opposer did not produce the documents constituting OX 79 in discovery or identify them – generally or specifically – in its pretrial disclosures. (Martens Decl. ¶ 4, Ex. C.) Accordingly, OX 79 is subject to exclusion pursuant to 37 C.F.R. § 2.123(e)(3), as well. *See Wonderbread 5 v. Gilles*, 115 U.S.P.Q.2d 1296, 1300 (TTAB 2015) (Board struck all exhibits to trial testimony because respondent "fail[ed] to summarize "the types of documents and things [he] intended to introduce as exhibits to his testimony.")

lacks foundation to testify as to which products compete with the products offered under Applicant's marks. In fact, Raeder-Devens never offers such testimony, instead only testifying that certain of the products listed in OX 79 compete with Opposer's products. (Trial Testimony of Jennifer Raeder-Devens, 38:8-13 , 40:20-25, 41:22-42:5, 43:3-6.) Notably, certain of Applicant's products offered under its marks remain in development and/or have not been commercialized yet, and, thus, do not have competitors in the marketplace.

G. Notice of Reliance re: Third Party Registrations (Dkt No. 50)

Opposer's Notice of Reliance offering printouts of third party registrations of marks for surgical drapes, medical dressings, and skin preparations, or products related thereto, is irrelevant to whether Applicant's marks are likely to be confused with Opposer's marks. Opposer does not, and cannot, represent that the listed third party registrations reflect each and every registered mark for surgical drapes, medical dressings, and skin preparations, or products related thereto, or products containing chlorhexidine. Absent any such representation, the list is meaningless. It is akin to a list of all the individuals named "Robert" living in Los Angeles as proof that no one named "Stephen" lives in Los Angeles. The mere fact that third parties use various marks for surgical drapes, medical dressings, and skin preparations, or products related thereto, is not relevant to the consideration of the issue of likelihood of confusion. The third party registrations are merely a distraction and irrelevant to the issue at hand.

H. Notice of Reliance re: Opposer's CHLORAPREP MAX-TINT ORANGE Application (Dkt No. 48)

Opposer's Notice of Reliance offering Opposer's application to register CHLORAPREP MAX-TINT ORANGE into evidence is irrelevant to the issues at bar and, thus, should be excluded. Opposer states that it offered the application status to demonstrate Opposer's continued interest in and development of the CHLORAPREP mark. Applicant, however does

not dispute that Opposer maintains an interest in its CHLORAPREP mark. It has not petitioned to cancel the CHLORAPREP mark or challenged Opposer's standing.

Additionally, Opposer's application to register CHLORAPREP MAX-TINT ORANGE has no bearing on the issue of confusion in this case. The CHLORAPREP MAX-TINT ORANGE application is irrelevant to Opposer's argument that it owns a family of CHLORA-prefixed marks. The application was filed well after Applicant filed its applications at issue and was filed on an intent-to-use basis. As discussed in Applicant's Trial Brief, "[t]o establish a family of marks, opposer must prove that, prior to applicant's first use of its mark, opposer established its family of marks." *Citigroup Inc. v. Capital City Bank Group Inc.*, 94 U.S.P.Q.2d 1645, 1647 (TTAB 2010). Accordingly, the application cannot be used to establish that Opposer owns a family of marks.

Dated: October 5, 2015

Respectfully submitted,

SHEPPARD, MULLIN, RICHTER & HAMPTON LLP

By

/s/ Lisa M. Martens

LISA M. MARTENS

PAUL A. BOST

Attorneys for Applicant,
ENTROTECH LIFE SCIENCES, INC.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of application Serial Nos.:

85/499,349 for the mark **CHLORADERM**
85/499,345 for the mark **CHLORABSORB**
85/499,337 for the mark **CHLORABOND**
85/499,332 for the mark **CHLORADRAPE**

Filed on December 19, 2011

Published in the *Official Gazette* on May 29, 2012

CAREFUSION 2200, INC.,

Opposer,

v.

ENTROTECH LIFE SCIENCES, INC.,

Applicant.

Combined Opposition Proceeding No.: 91-206,212

DECLARATION OF LISA M. MARTENS

I, Lisa M. Martens, hereby declare and state as follows:

1. I am a Partner with the law firm of Sheppard Mullin Richter & Hampton LLP, which represents Applicant Entrotech Life Sciences, Inc. (“Applicant”) in this proceeding. I am duly licensed to practice law in the states of California and Illinois, and am authorized to practice before the Trademark Trial and Appeal Board of the United States Patent and Trademark Office. I have personal knowledge of the facts stated in this declaration and can and would testify truthfully thereto if called upon to do so.

2. Annexed hereto as **Exhibit A** is a true and correct copy of Opposer’s Rebuttal Disclosures as served on June 5, 2015.

3. Annexed hereto as **Exhibit B** is a true and correct copy of Opposer's Notice of Rebuttal Testimony Deposition of Carol Schultz, RN.

4. Opposer did not produce a chart entitled "Third Party Competitors" constituting OX 79 in discovery or identify such a chart, or any competitors – generally or specifically – in its pretrial disclosures. Annexed hereto as **Exhibit C** is a true and correct copy of Opposer's Pre-Trial Disclosures.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct to the best of my personal knowledge and understanding.

Executed October 5, 2015, at San Diego, California.

/s/ Lisa M. Martens

Lisa M. Martens

EXHIBIT A

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

IN THE MATTER OF Trademark Application Serial Nos. 85/499349; 85/499345; 85/499337
and 85/499332

DATE OF PUBLICATION: May 29, 2012

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| CareFusion 2200, Inc., | : | |
| | : | |
| Opposer, | : | |
| | : | |
| v. | : | Combined Opposition No.: 91206212 |
| | : | |
| Entrotech Life Sciences, Inc., | : | |
| | : | |
| Applicant. | : | |

**REBUTTAL DISCLOSURES OF
OPPOSER CAREFUSION 2200, INC.**

Pursuant to Rule 2.121(e) of the Rules of Practice of the Trademark Trial and Appeal Board and F.R.C.P. 26(a)(3), Opposer CareFusion 2200, Inc. (“CareFusion”) makes the following rebuttal disclosures:

I. Identification of individuals likely to give testimony as witnesses:

A. Jennifer Raeder-Devens
Vice President, R&D Engineering Management
CareFusion Corporation

Ms. Raeder-Devens will rebut testimony provided by George Holinga regarding the incise drape development project and testimony provided by Jim McGuire regarding CareFusion’s abilities with respect to the development and commercialization of medical products.

B. Carol Schultz, RN
Regional Director of Quality
Lakeshore Region of Presence Health
2900 N. Lakeshore Drive
Chicago, IL 60657

Ms. Schultz will rebut testimony provided by Jim McGuire regarding recognition of the ChloraPrep brand by medical professionals.

All witnesses are represented by counsel for CareFusion and may be contacted only through CareFusions's counsel in this matter.

Respectfully submitted,

DREITLER TRUE LLC

/Joseph R. Dreitler/

Joseph R. Dreitler

Mary R. True

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Columbus, OH 43206

Telephone: 614-449-6677

E-mail: jdreitler@ustrademarklawyer.com

E-mail: mtrue@ustrademarklawyer.com

Attorneys for Opposer

CareFusion 2200, Inc.

Dated: June 5, 2015

CERTIFICATE OF SERVICE

This will certify that on the 5th day of June, 2015, a true and correct copy of the *Rebuttal Disclosures of Opposer CareFusion 2200, Inc.* was served via e-mail to hickey@fr.com.

/Joseph R. Dreitler/
Joseph R. Dreitler

EXHIBIT B

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

**IN THE MATTER OF Trademark Application Serial Nos. 85499349; 85499345; 85499337
and 85499332**

DATE OF PUBLICATION: May 29, 2012

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| CareFusion 2200, Inc., |) | |
| |) | |
| Opposer, |) | Combined Opposition No. 91206212 |
| |) | |
| v. |) | |
| |) | |
| Entrotech Life Sciences, |) | |
| |) | |
| Applicant. |) | |

NOTICE OF REBUTTAL TESTIMONY DEPOSITION OF CAROL SCHULTZ, RN

PLEASE TAKE NOTICE that pursuant to 37 C.F.R. § 2.123(a), Opposer CareFusion 2200, Inc. will take the rebuttal testimony deposition upon oral examination of Carol Schultz, RN, Regional Director of Quality, Lakeshore Region of Presence Health. The deposition testimony will be recorded by stenographic means at the offices of Nixon Peabody, Three First National Plaza, 70 West Madison, Suite 3500, Chicago, IL 60602. Ms. Schultz will rebut testimony provided by Jim McGuire regarding recognition of the Chloraprep brand by medical professionals. The deposition will commence at 3:00 pm on Tuesday, June 23, 2015. If necessary, the deposition will be adjourned until completed.

Dated: June 9, 2015

Respectfully submitted,

/s/ Mary R. True

Mary R. True

Joseph R. Dreitler

DREITLER TRUE LLC

19 E. Kossuth St.

Columbus, Ohio 43206

Telephone: (614) 449-6642

Email: jdreitler@ustrademarklawyer.com

mtrue@ustrademarklawyer.com

Attorneys for Opposer CareFusion 2200, Inc.

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing has been served via electronic mail upon Applicant's attorney of record in this proceeding on this 9th day of June, 2015 to the following email address: hickey@fr.com.

/s/ Mary R. True

Mary R. True

EXHIBIT C

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

IN THE MATTER OF Trademark Application Serial Nos. 85/499349; 85/499345; 85/499337
and 85/499332

DATE OF PUBLICATION: May 29, 2012

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| CareFusion 2200, Inc., | : | |
| | : | |
| Opposer, | : | |
| | : | |
| v. | : | Combined Opposition No.: 91206212 |
| | : | |
| Entrotech Life Sciences, Inc., | : | |
| | : | |
| Applicant. | : | |

**PRETRIAL DISCLOSURES OF
OPPOSER CAREFUSION 2200, INC.**

Pursuant to Rule 2.121(e) of the Rules of Practice of the Trademark Trial and Appeal Board and F.R.C.P. 26(a)(3), Opposer CareFusion 2200, Inc. (“CareFusion”) makes the following pretrial disclosures:

I. Identification of individuals likely to give testimony as witnesses:

A. Jan Creidenberg
Vice President, Marketing Manager
CareFusion Corporation

Mr. Creidenberg may testify on the uses of Opposer’s topical antimicrobial products, including products bearing the CHLORA__ formative marks, including information on the persons who use them, how they are used, for what purposes and what other products are often used in connection with Opposer’s products; Opposer’s advertising, marketing and promotion of Opposer’s topical antimicrobial products, including products bearing the CHLORA__ formative marks; Opposer’s sales of products bearing the CHLORA__ formative marks, including information on the marketing channels in which such products are advertised, marketed, promoted and/or sold and competitive antimicrobial products, and information regarding plans for the introduction of new topical antimicrobial products, including products bearing the CHLORA__ formative marks.

Mr. Creidenberg may also testify regarding the business relationship between Opposer (and its related company CareFusion 213 LLC) and Applicant's related entity, Entrofoor Medical, LLC, for the purpose of Entrofoor Medical, LLC developing and manufacturing chlorhexidine drape for CareFusion 2200 to license and distribute.

B. Colleen Glynn
Director, Marketing and Product Management
CareFusion Corporation

Ms. Glynn may testify on how Opposer's topical antimicrobial products, including products bearing the CHLORA formative marks, are sold, to whom and their prices, and on total sales of Opposer's topical antimicrobial products, including products bearing the CHLORA formative marks.

C. Jennifer Raeder-Devens
Vice President, R&D Engineering Management
CareFusion Corporation

Ms. Raeder-Devens may testify on the development and research connected with Opposer's topical antimicrobial products, and on plans for the introduction of new topical antimicrobial products, including products bearing the CHLORA formative marks.

Ms. Raeder-Devens may also testify regarding the business relationship between Opposer and Applicant's related entity, Entrofoor Medical, LLC, for the purpose of Entrofoor Medical, LLC developing and manufacturing chlorhexidine drape for CareFusion 2200 to license and distribute.

D. Dr. John Foor, M.D.
Medical Consultant
Entrotech Life Sciences

Dr. Foor may testify about the recognition of the Chloraprep brand in the medical/surgical community, his personal knowledge of the Chloraprep brand, and about the formation of Entrofoor Medical, LLC and its business relationship with Opposer for the purpose of Entrofoor Medical, LLC developing and manufacturing chlorhexidine drape for CareFusion 2200 to license and distribute.

All witnesses, with the exception of Dr. Foor, are represented by counsel for CareFusion and may be contacted only through CareFusion's counsel in this matter.

II. Description of Documents Upon Which Opposer May Rely

Examples of advertising, marketing and promotional materials for Opposer's topical antimicrobial products, including products bearing the CHLORA__ formative marks

Evidence of advertising and marketing expenditures for Opposer's topical antimicrobial products, including products bearing the CHLORA__ formative marks

Evidence regarding the dollar amount of sales of Opposer's topical antimicrobial products, including products bearing the CHLORA__ formative marks

Evidence regarding the channels of trade for the sales of Opposer's topical antimicrobial products, including products bearing the CHLORA__ formative marks

Examples of products bearing Opposer's CHLORA__ formative marks

File history from USPTO on Opposer's CHLORA__ formative marks

Documents relating to the business relationship between Opposer's related entity CareFusion 213, LLC and a related entity to Applicant, Entrofoor Medical, LLC.

Respectfully submitted,

DREITLER TRUE LLC

/Joseph R. Dreitler/

Joseph R. Dreitler

Mary R. True

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Telephone: 614-449-6677

E-mail: jdreitler@ustrademarklawyer.com

E-mail: mtrue@ustrademarklawyer.com

*Attorneys for Opposer
CareFusion 2200, Inc.*

Dated: February 5, 2015

CERTIFICATE OF SERVICE


This will certify that on the 5th day of February, 2015, a true and correct copy of the *Pretrial Disclosures of Opposer CareFusion 2200, Inc.* was served via e-mail to hickey@fr.com.

/Joseph R. Dreitler/
Joseph R. Dreitler

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing document has this 5th day of October, 2015 been mailed by electronic mail, as agreed to by counsel for the parties, to Opposer's counsel of record:

Joseph R. Dreitler, Esq.
Mary R. True, Esq.
DREITLER TRUE, LLC
jdreitler@ustrademarklawyer.com
mtrue@ustrademarklawyer.com



Louie Perez